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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,382	01/02/2004	Hideki Morikaku	Q79253	9135
23373	7590	06/15/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			TAMAI, KARL I	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/749,382

Applicant(s)

MORIKAKU ET AL

Examiner

Tamai IE Karl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/04, 9/04, 1/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The examiner notes that two references were cross off the USPTO 1449 received on 9/10/2004 because it was unclear to which references the cites refer. The examiner notes JP 64-060240 and JP 55-141947 were provided by the Applicant but not cited on a USPTO 1449. These two references are cited on the PTO 892.

Drawings

2. Figures 10-17 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

5. Claims 4, 5, and 6 are objected to because of the following informalities: Claim 4 is objected to because the warping due to differences in the coefficient of expansion is a method of making limitation that is not germane to the patentability of the apparatus. Claim 6 is objected to because the condition that the winding assembly is inserted in the slot through the insulator is a method of making limitation which is not germane to the patentability of the apparatus. The claims are being treated as a product by process limitation such that as a product by a process claim "even though the product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product by process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process". *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966(Fed. Cir. 1985). Claim 4 does not provide antecedent basis for "the end". Claim 5 does not provide antecedent basis for "both end edge portions" and "the opening portion". Claim 6 does not provide antecedent basis for "end of one flat edge portion", "the other flat edge portion", and "the opening portion". Appropriate correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2 and 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Beck. (WO94/02986). Beck teaches a teaches stator body with vertical axial slots 46 having windings 58 wound in slots 46 with a slot liner with a NOMEX paper layer 192', 194', 196' on the winding side and a resin 252 on the core side. The stator winding is a row in the bottom of the slot (figure 9, and is inherently a continuous wire for the winding.

8. Claims 1-3 and 7-9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Framery et al. (Framery)(WO01/93406)(examiner relies on Chochoy et al. [US 6774511] as an English Translation of the Framery et al.). Framery teaches stator body 22 with axial slots (vertical or horizontal depending on the positioning of the stator) having copper coil windings 32 (inherently continuous for a portion of the coil) wound in rows slots 28 with a slot liner with a paper layer 74 and a resin layer 76. Framery teaches one or both faces of the paper can be coated with the resin layer 76. Framery teaches the outer resin layer has paper layer on the inside and the inner layer has a paper layer in the inside.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beck or Framery, in further view of Rejda (US 3130335). It is inherent that the resin and paper layers have different expansion coefficients. Beck or Framery teach every aspect of the invention except the shape of the insulator warping towards the ends or the end flat against the inner face of the other flat edge to close the opening. Rejda teaches the shape of the insulator having curving (warping) towards the ends (figs 1-3) and the end flat against the inner face of the other flat edge to close the opening (fig 4) to be a simple and reliable slot liner that is easily utilized in the manufacturing of the machine. It would

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have been obvious to a person of ordinary skill in the art at the time of the invention to construct the machine of either Framery or Beck with the shape of Rejda to allow for easy assembly during manufacture of the machine.

The examiner notes that no patentable weight has been given to the warping of the insulator by the coefficient of expansion because the apparatus could also be molded or bend into the claimed shape.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Beck or Framery, in further view of Katou (US 6674211). Beck or Framery teach every aspect of the invention except insulator having ends with flat portions from a inwardly curved portion or one end flat against the inner face of the other flat edge to close the opening. Katou teaches (figure 3) the insulator 3 curving inward sides and flat ends that curve inward at different angles to resiliently secure insulator in slot prior to the winding insertion. It would have been obvious to a person of ordinary skill in the art at the time of the invention to construct the machine of either Framery or Beck with the shape of Katou to allow for the insulator to be held in the slot during assembly.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl I.E. Tamai whose telephone number is (571) 272 - 2036.

The examiner can be normally contacted on Monday through Friday from 8:00 am to 4:00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg, can be reached at (571) 272 - 2044. The facsimile number for the Group is (703) 872 - 9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl I Tamai
PRIMARY PATENT EXAMINER
June 13, 2005



KARL TAMAI
PRIMARY EXAMINER